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OFFICE OF PETITIONS

In re Application of :
Walker et al. :
Application Number: 09/387219 : DECISION DISMISSING PETITION
Filing Date: 08/31/1999 :
Attorney Docket Number: 34149- :
703.401 :

This is a decision in response to the REQUEST FOR WITHDRAWAL OF ABANDONMENT filed on June 24, 2009, which is treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is **DISMISSED**.

The application became abandoned on May 1, 2001, for failure to file a timely reply to the non-final Office action mailed on January 31, 2001. An untimely reply, including a request for a Continued Prosecution Application (CPA), was filed on July 31, 2001, but did not include the required extension of time. Notice of Abandonment was mailed on May 11, 2009.

Applicants assert, in pertinent part, that the application was erroneously held abandoned because "all requirements for filing a CPA have been met" and "there was never any allegation that the conditions for filing a CPA had not been met until the Abandonment was mailed on May 11, 2009."

A review of the record reveals the following:

1. On January 31, 2001, the non-final Office action was mailed, setting a three (3) month shortened statutory period for reply.

2. On July 31, 2001, a request for a CPA was filed. The request, however, did not include payment of the CPA fee or the required extension of time fees. Additionally, the CPA request did not include a general authorization to charge any required fees.

3. On October 31, 2001, a Notice to File Missing Parts of Application (CPA) was mailed, stating that the statutory basic filing fee was missing and that a three (3) month extension of time fee was needed. A two (2) month shortened period for reply was set.

4. On February 14, 2002 (certificate of mailing January 31, 2002), applicants submitted a response to the Notice to File Missing Parts, including a one (1) month extension of time. Petitioners provided, on January 7, 2004, a copy of a check for \$950.00 asserted to have been filed with the reply filed on February 14, 2002.

5. On October 2, 2002, a Notice to File Missing Parts of Application (CPA) was filed, stating that the statutory basic filing fee and a one (1) month extension of time fee were required. The Notice stated that the fees were received on February 14, 2002, but were refunded, and requested resubmission of the fees.

6. On January 7, 2004, a response to the Notice to File Missing Parts of Application (CPA) was filed. The response asserted that no refund of fees had been received, and that the Notice mailed on October 2, 2002, was mailed in error.

7. On May 4, 2009, a power of attorney and statement under 37 CFR 3.73(b) were filed.

8. On May 11, 2009, Notice of Abandonment was mailed, stating the application was abandoned for failure to timely file a proper reply to the Office letter mailed on January 31, 2001.

9. On June 24, 2009, the subject petition was filed.

35 U.S.C. 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action,

the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.135 states, in pertinent part:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

The non-final Office action mailed on January 31, 2001, set a three (3) month shortened statutory period for response. A reply with the proper extension of time was not filed prior to the expiration of the extendable period for reply, which ended on July 31, 2001. Accordingly, the application became abandoned as a matter of law on May 1, 2001, for failure to timely respond to the Office action mailed on January 31, 2001, which set a three (3)-month shortened statutory period for reply.

The Office should have mailed a Notice of Abandonment rather than mailing the Notice to File Missing Parts on October 31, 2001, and on October 2, 2002. Nevertheless, abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.¹

In this regard, MPEP 711.03(c) states that a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicants' reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicants of any deficiency in sufficient time to permit the applicant to take corrective action.²

¹ MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-300 (CCPA 1964); Krahn v. Commissionerr, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

² See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Rather, the U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.³ Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.⁴

The Office regrets the delay in informing applicants that the application is abandoned. However, the showing of record is that the abandonment resulted from the failure of petitioners to file a timely and proper response to the final Office action, rather than an error on the part of the USPTO.

Lastly, with regards to the refund of fees, a review of Office financial records reveals that a check in the amount of \$950.00 was received on February 21, 2002, but that a refund of \$490.00 was issued.

The Notices to File Missing Parts mailed on October 31, 2001, and on October 2, 2002, were mailed in error, and are hereby **vacated**.

The application is referred to Technology Center Art Unit 1612 for further processing consistent with this decision.

Petitioner may wish to consider filing a petition to revive under 37 CFR 1.137(b).

A reply should be submitted within two (2) months of the mailing date of this decision. **This time period is not extendable.** 37 CFR 1.181(f).

³ Link v. Wabash, 370 U.S. 626, 633-34 (1962).

⁴ Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

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